

### **REMARKS/ARGUMENTS**

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set are fully supported by the originally filed specification.

#### ***Claim Objections***

The Examiner has objected to typographical errors in claim 39. Claim 39 was previously cancelled from the application. Accordingly, the Examiner's objection regarding claim 39 is moot.

#### ***Claim Rejections - 35 USC 112***

Claims 1, 13, 24, and 30 have been rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In accordance with the Examiner's suggested amendment, claims 1, 13, 24, and 30 have been amended such that the term "using sensed coded data" is now "using coded data". Thus, the claims now satisfy the requirements under 35 U.S.C. 112.

#### ***Double Patenting***

With Respect to the double patenting rejection, the Applicant submits a Terminal Disclaimer (enclosed) under 37 CFR 1.321(c), in order to overcome the nonstatutory double patenting rejection, in view of U.S. Application No. 10/291.821.

#### ***Claim Rejections - 35 USC 103***

The Examiner has rejected to claims 1 to 10, 12 to 22, 24 to 28, 30 to 33, and 39 to 42 under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,081,261 to Wolff *et al.* in view of US Patent 5,477,012 to Sekendur, and in view of US Patent 4,864,618 to Wright *et al.* In particular, the Examiner has rejected claim 1 as being unpatentable over Wolff in view of Sekendur.

The Applicant respectfully submits that although the cited prior art references cannot be combined, the present claim 1 is patentable over Wolff in view of Sekendur.

In particular, the present claim 1 describes providing a printed registration form, the form including coded data, where the coded data has a plurality of coded data portions. Claim 1 further describes each coded data portion being indicative of:

- (i) an identity of the form, and
- (ii) at least one reference point of the form.

On page 9 of the Office Action, the Examiner has directed the Applicant to column 4 lines 10 to 60 as apparently describing the afore-mentioned features of claim 1. However, in contrast to claim 1, Sekendur describes a surface formatted with a position-related coding means for indicating X-Y coordinates capable of reflecting a frequency of light (see column 4 lines 16 to 18). Sekendur continues to explain that the coding means includes a plurality of dots, where each dot is divided into three concentric circles, the outer ring representing the X coordinate and the inner ring representing the Y coordinate. It is the combination of dark and light slices in the rings of each dot that indicates an X-Y coordinate (see column 4 lines 28 to 41 and Figures 1 and 2).

If one is to take the dots of Sekendur as the coded data of claim 1, then it is possible to interpret the coded data portion of claim 1 as the rings or the slices of the dots in Sekendur. Claim 1 requires that each coded data portion is indicative of an identity of the form and at least one reference point of the form. Neither the dots, slices nor the rings in Sekendur indicate an identity of the form and at least one reference point of the form.

As pointed out above, the rings in Sekendur represent either the X or the Y coordinate. It is the combination of the rings that indicates an X-Y coordinate. Thus, each ring in itself is not indicative of a reference point or an identity of the form. Similarly, it is the combination of

dark and light slices in the rings that indicate the X-Y coordinate, each dark and light slice does not indicate an identity of the form and at least one reference point of the form.

Therefore, the Applicant fails to see any description of each coded data portion being indicative of an identity of the form and at least one reference point of the form in either Wolff, Sekendur, or a combination thereof.

The Applicant respectfully submits that in order to prove a *prima facie* case of obviousness, the Examiner must establish all of the claim limitations in the prior art references, or references when combined (see MPEP 2143).

As the Examiner has failed to show all of the claim limitations of claim 1 in the cited references (or references when combined), the present claim 1 is patentable over Wolff in view of Sekendur, and favourable reconsideration of the present claims is therefore earnestly requested.

**CONCLUSION**

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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